



01-23-04

Attorney Docket # 990589RE/LH

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Applicant(s): Y. SHIMADA
Serial No. : 10/613,664
Filed : July 2, 2003
For : SCANNING OPTICAL MICROSCOPE
Art Unit : 2878
Examiner : Not Yet Assigned

**INFORMATION DISCLOSURE STATEMENT
WITH STATEMENT UNDER 37 CFR 1.97(e)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R :

Submitted herewith are the following:

- (1) Copy of a Japanese Office Action dated November 13, 2003 (and English translation thereof) issued in a Japanese Application which is a Divisional of Japanese application No. 10-269561 which is the priority application in which the present application is based;
- (2) Copies of the cited publications; and
- (3) Form PTO/SB/08A. It is requested that an initialed copy the Form PTO/SB/08A be returned to indicate that the publications listed therein have been considered and made of record.

An English translation of said Japanese Office Action is provided, thereby satisfying the requirements for a concise explanation of relevance for any non-English language publications cited therein (MPEP 609 III A(3)).

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I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service with sufficient postage under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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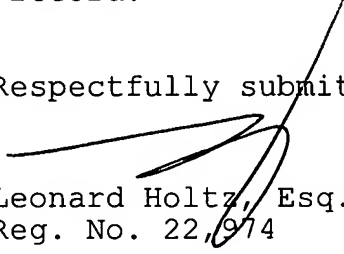
In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper to Account No. 06-1378.

STATEMENT UNDER 37 CFR 1.97(e) (1)

Each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the present Information Disclosure Statement. Said Communication bears a mailing date of November 13, 2003. Therefore, the filing of this Information Disclosure Statement is timely under the provisions of 37 CFR 1.97(e) and does not require a fee.

It is respectfully requested that the attached publications be considered and made of record.

Respectfully submitted,


Leonard Holtz, Esq.
Reg. No. 22,974

Encls.

Dated: January 21, 2004

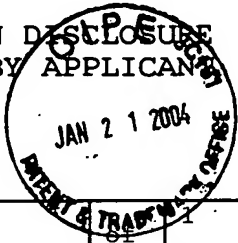
Frishauf, Holtz, Goodman & Chick, P.C.
767 Third Avenue, 25th Floor
New York, New York 10017-2023
Tel. No. (212) 319-4900
Fax. No. (212) 319-5101
LH/sdf

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PTO/SB/08A (08-00)

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Substitute for Form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT 		Application Number	10/613,664
		Filing Date	July 2, 2003
		First Named Inventor	Y. SHIMADA
		Group Art Unit	2878
		Examiner Name	Not Yet Assigned
Sheet	1	Attorney Docket Number	990589RE/LH

U.S. PATENT DOCUMENTS

Exam. Inits*	Cite No ¹	Document Number	Kind Code ²	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion

FOREIGN PATENT DOCUMENTS

Exam Inits*	Cite No ¹	Offc ³	Document Number ⁴	Kind Code ⁵	Name of Patentee or Applicant	Publication Date MM-DD-YYYY	Relevant Portion	T ⁶
	A	JP	53-135660			11-27-1978		
	B	JP	4-350816	A		12-04-1992		
	C	JP	5-509417	A		12-22-1993		

Examiner Signature		Date Considered	
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* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Place a check here if English translation is attached.

DATE MAILED: January 21, 2004

(Translation)



Mailed: November 13, 2003

NOTIFICATION OF REASONS FOR REJECTION

Patent Application No.: 2003-322166

Examiner's Notice Date: October 31, 2003

Examiner: T. Satomura

This application is rejected on the grounds stated below. Any opinion about the rejection must be filed within 60 DAYS of the mailing date hereof.

REASONS

1. The invention according to a claim 1 indicated below in the present application is unpatentable under Section 29 (2) of the Patent Law, as being such that the invention could easily have been made by a person with ordinary skill in the art to which the invention pertains, on the basis of the inventions described in publications, indicated below, distributed in Japan or a foreign country prior to this application.

2. The application fails to satisfy the requirements under Section 36 (6) (ii) of the Patent Law, on the grounds that the claims are defective in a respect stated below.

REMARKS

References Cited:

1. Jpn. Pat. Appln. KOKAI Publication No. 04-350816
- Prior-Art Document 1: Jpn. Pat. Appln. KOKAI Publication No. 05-509417
- Prior-Art Document 2: Jpn. Pat. Appln. KOKAI Publication No. 53-135660

<Re: Claim 1>

Reason: Reason 1

References: Reference 1 and Prior-Art Documents 1 and 2

The elements "acoustooptical element 26" and "dichroic mirror 20" in a confocal fluorescence microscope disclosed in reference 1 correspond to "spectral decomposing means" and "wavelength dividing means" of the present invention, respectively.

When the confocal fluorescence microscope in reference 1 and the present invention are compared with each other, it is found that they are different in a point wherein the present invention further decomposes fluorescence into a number of flux of light of wavelength bands, but a multi-wavelength fluorescence microscope was known before filing of the present application. Therefore, the present application is a mere combination of a known technique and the confocal fluorescence microscope in reference 1.

<Re: Claim 1>

Reason: Reason 2

The expression "the direction of the axial center . . . made to substantially coincide with a plane in which spectral decomposition is performed" is awkward in Japanese. Thus, the invention according to claim 1 is not clear.

(It is considered that the expression "the direction of the axial center . . . substantially parallel to a plane" is more appropriate.)

The claims not mentioned in this Official Action are not rejected. If a new reason for rejection is noticed, a further Official Action will be issued.

Prior Art Search Report (which does not constitute the reasons for rejection)

<Searched Field>

IPC seventh ed.

G02B19/00-21/00, 21/04-36

G01N21/64

<Prior-Art Documents Showing General Technical Level>

- Description concerning the photosensitivity distribution of a side-on type PMT
Jpn. Pat. Appln. KOKAI Publication No. 06-109635 (FIG. 7)

Jpn. Pat. Appln. KOKAI Publication No. 08-43739

Jpn. Pat. Appln. KOKAI Publication No. 2003-57556

Jpn. Pat. Appln. KOKAI Publication No. 2000-97858